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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/646,429

08/22/2003

Robert L. Billmers

3043.FDI

9142

86379

7590

04/13/2011

National Starch LLC

Patent Dept. Karen Kaiser

10 Finderne Avenue

Bridgewater, NJ 08807-0500

EXAMINER

TRAN LIEN, THUY

ART UNIT

PAPER NUMBER

1789

NOTIFICATION DATE

DELIVERY MODE

04/13/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@nstarch.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/646,429	BILLMERS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Lien T. Tran	1789	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2011.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 11-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

The 112 first and second paragraph rejections are hereby withdrawn due to the amendment and argument filed on 1/21/11

Claims 1-8, 11-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Judkins et al ( 6033697) in view of Carver et al ( US 2003/0039741A1).

Judkins et al disclose a coated frozen par-fried potato product and process of making the product. The process comprises the steps of cutting potato into pieces, blanching the pieces, contacting the pieces with an aqueous solution of one or more hydrocolloids, coating the pieces with an aqueous starch-based batter and frying the coated pieces. Suitable hydrocolloids include starches, modified starches, gum, dextrin etc... and mixtures thereof. The starch batter may contain one or more starches and flours such as wheat flour. The par-fried product is frozen and is prepared for consumption by finish frying. ( see col. 2 lines 16-53, col. 3 lines 50-55, col. 4 lines 64-67 and col. 5

Judkins et al do not disclose the starch is substituted with succinate and the characteristics of the starch as in claims 3-7, the percent of fat reduction, reconstitution by oven heating, blanching in water containing the starch as in claim 20.

Carver et al disclose a co-processed composition containing a combination of modified starch and flour. The sources for the starch include corn, potato, wheat, rice, tapioca etc... The base starch for modification includes conversion products including fluidity or thin-boiling, thermal, heat and or acid dextrinization etc.., The modification includes succinate and substituted succinate derivatives or starch. Stabilized starch including starch octenylsuccinate can also be used. The composition demonstrates a

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combination of desirable appearance, taste, process tolerance, emulsification, cold and hot temperature stability and instant viscosity properties. The composition can be used in products including batters, coatings, glazes etc... ( see paragraphs 0015,0016.0018, 0030, 0036, 0037)

The language " a coating consisting essentially of" does not define over the prior art. Section 2111.03 of the MPEP states " consisting essentially of" will be construed as equivalent to " comprising" for the purposes of searching for and applying prior art absent a clear indication in the specification or claims of what the basic and novel characteristics actually are". Thus, the language does not define over Carver et al disclosure of a co-processed of starch and flour. Page 6 of the specification discloses additional ingredients added to the coating, including flour. Judkins et al teach to coat the pieces with a starch batter comprising starch and flour; thus, it would have been obvious to one skilled in the to use the composition of Carver et al in the starch batter of Judkins to obtain the superior properties taught by Carver et al. The Judkins et al product is subjected to frying, freezing and finish frying; thus, the cold and hot temperature stability of the Carver et al composition is especially advantageous. Since Carver et al disclose starch substituted with succinate and can also be converted, it is obvious the starch has the characteristics in claims 3-4. Since Carver et al disclose starch substituted with succinate, it is obvious the starch is prepared using the amount of succinic anhydride as claimed. In any event, modification of starch is well known in the art; thus, it would have been within the skill of one in the art to determine the appropriate amount of reagent without undue experimentation. Judkins et al in view of

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Carver et al disclose the same coating as claimed; thus, it is inherently obvious the fat reduction is obtained. It would have been obvious to reconstitute by oven heating when desiring to avoid the additional fat obtained by finish frying. This would have been readily apparent to one skilled in the art. Judkins et al teach contacting with a solution containing one or more hydrocolloids; this is the same as the blanching step of claim 20 because it is contacting the pieces with solution containing water; the claim does not exclude additional blanching step. The hydrocolloids can be modified starches; thus, it would have been obvious to use the Carver et al composition in the hydrocolloid solution to obtain the benefits disclosed by Carver et al. It would have been obvious to use additional starch coating depending on the thickness desired. It would have been obvious to use other starch coating than the one taught by Carver when desiring different flavor and taste.

Claims 1-8, 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keijbets ( 6635294) in view of Carver et al ( 6777015).

Keijbets disclose a frozen, fried potato product and a process of making it. The process comprises the steps of forming potato into pieces, blanching the pieces, contacting the pieces with an aqueous solution in which flour batter is added to coat the pieces, pre-frying the pieces and freezing the pieces. The flour batter contains flour, starch, dextrin, leavening agent, thickening agent etc.. ( see col. 3 and 4)

Keijbets does not disclose the starch is substituted with succinate and the characteristics of the starch as in claims 3-7, the percent of fat reduction, reconstitution by oven heating, blanching in water containing the starch as in claim 20.

Carver et al disclose a co-processed composition containing a combination of modified starch and flour. The sources for the starch include corn, potato, wheat, rice, tapioca etc... The base starch for modification includes conversion products including fluidity or thin-boiling, heat and or acid dextrinization, thermal etc... The modification includes succinate and substituted succinate derivatives or starch. Stabilized starch including starch octenylsuccinate can also be used. The composition demonstrates a combination of desirable appearance, taste, process tolerance, emulsification, cold and hot temperature stability and instant viscosity properties. The composition can be used in products including batters, coatings, glazes etc... (see paragraphs 0015,0016,0018, 0030, 0036, 0037)

The amendment of " a coating consisting essentially of" does not define over the prior art. Section 2111.03 of the MPEP states " consisting essentially of" will be construed as equivalent to " comprising" for the purposes of searching for and applying prior art absent a clear indication in the specification or claims of what the basic and novel characteristics actually are". Thus, the language does not define over Carver et al disclosure of a co-processed of starch and flour. Page 6 of the specification discloses additional ingredients added to the coating, including flour. Keijbets teaches the flour batter comprising starch and flour; thus, it would have been obvious to one skilled in the art to use the composition of Carver et al in the flour batter of Keijbets to obtain the superior properties taught by Carver et al. The Keijbets product is subjected to frying, freezing and finish frying; thus, the cold and hot temperature stability of the Carver et al composition is especially advantageous. Since Carver et al disclose starch substituted

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with succinate and can also be converted, it is obvious the starch has the characteristics in claims 3-4. Since Carver et al disclose starch substituted with succinate, it is obvious the starch is prepared using the amount of succinic anhydride as claimed. In any event, modification of starch is well known in the art; thus, it would have been within the skill of one in the art to determine the appropriate amount of reagent without undue experimentation. Keijbets in view of Carver et al disclose the same coating as claimed; thus, it is inherently obvious the same fat reduction is obtained. It would have been obvious to reconstitute by oven heating when desiring to avoid the additional fat obtained by finish frying. This would have been readily apparent to one skilled in the art. Keijbets teaches contacting with a solution containing the flour batter; this is the same as the blanching step of claim 20 because it is contacting the pieces with solution containing water; the claim does not exclude additional blanching step. It would have been obvious to use additional starch coating depending on the thickness desired. It would have been obvious to use other starch coating than the one taught by Carver when desiring different flavor and taste.

The 102 rejection of claims 1,2,7 over the Shi et al reference is hereby withdrawn due to the amendment filed on 1/21/11.

In the response filed 1/21/11, applicant argues the succinated coating of the present invention does not include any other materials which are significant and a skilled artisan would not substitute just the succinated starch as Carver states that it is essential to use a combination of starch and flour. This argument is not persuasive. It is not suggested to just use starch. As stated in the rejection, the language "consisting

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essentially of" is construed to be the same as comprising in absence of showing how other components critically affect the claimed composition. The specification discloses many ingredients including flour can be added to the coating; thus, there is no showing that flour critically affects the claimed composition. Applicant refers to the declaration filed on 1/21/11. The declaration is not persuasive. The declaration states that adding flour to the succinate starch raises the fat content. While the fat content is slightly different, the inclusion of flour does not critically affect the composition because the fat reduction still occurs in comparison to the control which is uncoated. The claims only require that the coated composition has a reduced fat content relative to an uncoated composition. The declaration does not show that a difference between 7.14 and 7.43 is statistically significant. Furthermore, the coating containing potato starch and flour in a ratio of 82.5:17.5 shows less fat than the potato starch alone. The difference between PS and PS:WF in ratio of 93:7 is very little. Thus, the showing is not conclusive to conclude that flour critically affects the function of the coating composition. As to the photographs, the purpose of the pictures is not clear. The showing in the declaration is also not commensurate in scope with the claims because the showing is restricted to waxy and potato starch while the claims are directed to any starch succinate. The highest percent of fat reduction shown is 23.5% while claim 11 recites a reduction of at least 30%.

Applicant makes the same argument with respect to the rejection over the Keijibets in view of Carver et al references. The argument is not persuasive for the same reason as set forth above.



Applicant's arguments filed 1/21/11 have been fully considered but they are not persuasive.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien T. Tran whose telephone number is 571-272-1408. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Humera Sheikh can be reached on 571-272-0604. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

April 7, 2011

/Lien T Tran/

Primary Examiner, Art Unit 1789